

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence (along with any paper referred to as being attached or enclosed) is being submitted *via* the USPTO EFS Filing System on the date shown below to Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Date: August 6, 2007

/Rebecca Stanford/
Rebecca Stanford

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Applicant(s): George D. Blankenship *et al.*

Examiner: Naeem U. Haq

Serial No: 09/838,970

Art Unit: 3625

Filing Date: April 20, 2001

Title: SYSTEM AND METHOD FOR MANAGING WELDING CONSUMABLES

**Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450**

REPLY BRIEF

Dear Sir:

Appellants' representative submits this Reply Brief in response to the Examiner's Answer mailed June 6, 2007. In the event any additional fees may be due and/or are not covered by the credit card, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1063 [LINCP105US].

REMARKS

Claims 1-57 are currently pending and are presently under consideration. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments herein. In particular, the following comments address deficiencies contended in the Examiner's Answer to appellants' Appeal Brief.

I. Rejection of Claims 37-44 Under 35 U.S.C. §101

Claims 37-44 stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. This rejection should be reversed for at least the following reasons. The instant claims produce a useful, concrete, and tangible result, and are thus eligible subject matter under 35 U.S.C. §101.

Beginning at page 23 of the Examiner's Answer (mailed June 6, 2007, hereinafter referred to as "EA"), the Examiner quotes a portion of appellants' disclosure that indicates a "component" can be, *inter alia*, software; suggests that software is equivalent to a program; cites portions of the MPEP that indicate a program can in some cases be regarded as non-statutory; then incorrectly concludes that the instant claims are therefore non-statutory. In particular, the Examiner freely notes at page 24 that "computer programs ***claimed as listings per se***" are non-statutory, but entirely ignores the fact that all "components" with respect to the subject claims are not claimed as listings *per se*, and, therefore, interpreting all components as such in erroneous. For example, even if the Examiner interprets a component as a program, then a first portion of claim 38 would read, "***a consumable monitor [program] that monitors consumable usage and/or consumable status of a welder***". Structural or functional interrelationship is necessary in order to monitor consumable usage of a welder. However, a computer program listing as defined by the MPEP cannot "monitor consumables usage and/or consumable status of a welder" for the very same reason that the MPEP regards listings *per se* as non-statutory—that listings have no realized structure or function. Rather a program listing *per se* may include instructions for effecting the monitoring of consumable usage, but cannot itself, actually *e.g.*, monitor consumable usage.

In contrast, if there is some structure or function realized, as is the case here, then the component/program is not claimed as a listing *per se*, and is statutory. Yet the

Examiner's rejection relies on interpreting the term component as a listing *per se*, while at the same time foregoing analysis of the rest of the claimed aspects that clearly relate to structure and/or functional interrelations, and, thus, illustrate that such an interpretation is not germane. It is readily apparent that the instant claims produce a useful, concrete, and tangible result, and further apparent that the instant claims are not claimed as listings *per se*. Accordingly, this rejection should be reversed.

II. Rejection of Claims 37-44 Under 35 U.S.C §112

Claims 37-44 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Reversal of this rejection is respectfully requested for at least the following reasons. The subject claims particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

In particular, this rejection relies upon the same erroneous analysis noted in section I. *supra*, wherein the Examiner concludes that all components in all subject claims are nothing more than listings or algorithms. Once more, this conclusion is drawn based upon a single word (*i.e.*, software) in the specification rather than based upon an examination of the claims as a whole in order to determine of said word is an appropriate or reasonable interpretation.

Independent claim 38 recites, “a consumable monitor component ***that monitors consumable usage and/or consumable status of a welder***”. The Examiner argues that a component is nothing more than an algorithm since the specification provides for the possibility that a component can be software, but entirely ignores the fact that while an algorithm might list *instructions for monitoring* consumable usage, an algorithm cannot itself *monitor* consumable usage. Therefore, the instant claims illustrate on their face that the consumable monitor component is not “merely an algorithm” and that treating all components as merely algorithms is inappropriate. Accordingly, this rejection should be reversed.

III. Rejection of Claims 1-9, 12, 15, 16, 21-23, 25-27, 32, 33, 35, 37 and 54 Under 35 U.S.C. §103(a)

Claims 1-9, 12, 15, 16, 21-23, 25-27, 32, 33, 35, 37 and 54 stand rejected under 35 U.S.C. §103(a) as being unpatentable over B.J. Bennett “Using a microcomputer is costing and selling” (hereafter referred to as Bennett) in view of Dialog File 148 “Retrospective” (hereafter referred to as Dialog. This rejection should be reversed for at least the following reasons. Bennett, Dialog, or a combination thereof do not teach or suggest all the claimed features.

Appellants’ representative points out, “the prior art reference (or references when combined) must teach or suggest *all* the claim limitations. The teaching or suggestion *to make the claimed combination and the reasonable expectation of success must be found in the prior art and not based on the Applicants’ disclosure*. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Accordingly, “all” the claim features must be taught or suggested, not just some or even most of the features claimed. It is readily apparent that Bennett (or a combination of Bennett and Dialog) does not teach or suggest “a remote system that interfaces *to the welder*”. Rather, Bennett teaches a Parameter Box that communicates with (*i.e.*, receives data from) a transducer. Pointedly, a transducer is not a welder. Accordingly, the combination does not teach *all* the claimed features, and this rejection should be reversed.

Page 25 of the EA argues that a transducer is a welder because the transducer “must be attached to the welder.” However, such analysis is inappropriate: Bennett clearly describes and defines a transducer and a welder as distinct components, just as appellants’ disclosure clearly defines and describes as distinct components both a welder and a consumable monitor component. The act of attaching one to the other does not remove a patentable distinction between the two. Moreover, under the premise set forth by the Examiner, a concrete floor is also a welder because the welder must be secured (attached) to the floor as is the assembly line or transits (also attached to the welder/floor) as well as the entire manufacturing plant that is clearly attached to the welder by some means. Arguing that a distinct object is attached to the welder does not transform that object into the welder, and both the object and the welder can have material distinctions. One such distinction is that appellants’ claims expressly recite “a remote system that

interfaces *to the welder*” whereas Bennett expressly teaches receiving data from a transducer, not the welder. Accordingly, neither Bennett nor a combination teach or suggest *all* the claimed limitations and this rejection should be reversed.

At page 26 of EA, the Examiner acknowledges Bennett does not teach interfacing *via* a computer network but suggests Dialog will cure this deficiency. Appellants’ representative reiterates, 1) there is no motivation to combine these references; and/or 2) the Examiner has impermissibly employed hindsight analysis. In particular, Dialog discloses *employing the Internet to monitor the quality of welds*, whereas Bennett relates to monitoring an amount of wire consumed in order to perform costing. The Examiner suggests the motivation is to remotely monitor the status of the weld (see EA at pg. 7), yet this argument is simply citing the feature to be included as the motivation itself, which, if permissible, renders the motivation test impotent. Based upon these references, there is no benefit taught or suggested that would arise by adding the ability to monitor weld quality over the Internet, and neither reference provides a motivation for making such a combination. Pursuant to *In re Vaeck*, the Examiner has thus failed to make a *prima facie* case for obviousness. However, the Examiner introduces a new reference, “Blackmon” (see EA at pg. 27) to suggest that welding consumables can contribute to welding flaws, yet this reference appears to have no bearing on the proposed combination or the claimed subject matter.

Most particularly, based upon what is actually taught by the references rather than based upon the Examiner’s hypothetical arrangements, one of ordinary skill, when confronted with Bennett’s costing mechanisms would not decide that what is needed is a way to monitor the quality of welds over the Internet (even considering the teachings of Blackmon). In addition, Bennett already teaches employing a serial connection to transmit a simple count (which is all that is taught or necessary according to the reference), so there is no purpose, benefit, or need to upgrade the serial connection in order to transmit the simple count. Accordingly, it is readily apparent the Examiner selected Dialog based entirely upon impermissible hindsight analysis by using appellants’ claims as a blueprint rather than based upon teachings or suggestions found in the references themselves.

IV. Rejection of Claims 10, 11, 17-19 and 36 Under 35 U.S.C. §103(a)

Claims 10, 11, 17-19 and 36 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bennett in view of Dialog and further in view of Tarr, *et al.* (U.S. 5,184,179). This rejection should be reversed for at least the reasons detailed in Appellants' Appeal Brief.

V. Rejection of Claims 13, 14 and 34 Under 35 U.S.C. §103(a)

Claims 13, 14 and 34 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bennett in view of Dialog and further in view of Official Notice. This rejection should be reversed and the Official Notice traversed for at least the reasons detailed in Appellants' Appeal Brief.

VI. Rejection of Claims 20 and 28-31 Under 35 U.S.C. §103(a)

Claims 20 and 28-31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bennett in view of Dialog and further in view of Sekizawa (U.S. 6,681,349 B2). This rejection should be reversed for at least the reasons detailed in Appellants' Appeal Brief.

VI. Rejection of Claim 24 Under 35 U.S.C. §103(a)

Claim 24 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Bennett in view of Dialog and further in view of Manchala, *et al.* (U.S. 6,405,178 B1). This rejection should be reversed for at least the reasons detailed in Appellants' Appeal Brief.

VII. Rejection of Claims 38 and 40-42 Under 35 U.S.C. §103(a)

Claims 38 and 40-42 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bennett. This rejection should be reversed for at least the reasons detailed in Appellants' Appeal Brief.

VIII. Rejection of Claims 39, 43, 45, 46, 48-53 and 55-57 Under 35 U.S.C. §103(a)

Claims 39, 43, 45, 46, 48-53 and 55-57 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bennett in view of Manchala, *et al.* (U.S. 6,405,178 B1). This rejection should be reversed for at least the reasons detailed in Appellants' Appeal Brief.

IX. Rejection of Claims 44 and 47 Under 35 U.S.C. §103(a)

Claims 44 and 47 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bennett in view of Manchala, *et al.* (U.S. 6,405,178 B1) in view of Official Notice. This rejection should be reversed and the Official Notice traversed for at least the reasons detailed in Appellants' Appeal Brief.

X. Conclusion

For at least the above reasons, the claims currently under consideration are believed to be patentable over the cited reference. Accordingly, it is respectfully requested that the Examiner's rejections be reversed.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [LINCP105US].

Respectfully submitted,
AMIN, TUROCY & CALVIN, LLP

/Himanshu S. Amin/

Himanshu S. Amin
Reg. No. 40,894

AMIN, TUROCY & CALVIN, LLP
24TH Floor, National City Center
1900 E. 9TH Street
Cleveland, Ohio 44114
Telephone (216) 696-8730
Facsimile (216) 696-8731